



Customer No. 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JEANNE-ROSE, et al.

Group Art Unit: 1615

Application No.: 09/902,660

Examiner: J. VENKAT

Filed: July 12, 2001

For: USE OF AN ORGANOMETALLIC
COMPOUND TO PROTECT
AND/OR STRENGTHEN A
KERATIN MATERIAL, AND
TREATMENT PROCESS

RECEIVED

DEC 05 2002

TECH CENTER 1600/2900

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

In response to the Restriction and Election Requirement dated October 2, 2002, the period for reply having been extended one month by a petition and fee filed concurrently herewith, reconsideration of the Requirement is respectfully requested in view of the following remarks.

The Office requires restriction under 35 U.S.C. § 121, and the Requirement may be summarized as follows:

- I. Claims 1-49, directed to methods and compositions comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **1a**.
- II. Claims 1-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **1b**.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
—202.408.4000—
Fax 202.408.4400
www.finnegan.com

- III. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **Ic**.
- IV. Claims 1-21 and 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **Id**.
- V. Claims 1-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **Ila**.
- VI. Claims 1-21 and 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **Ilb**.
- VII. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **Ilc**.
- VIII. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **Ild**.
- IX. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IIla**.
- X. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IIlb**.
- XI. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IIlc**.
- XII. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IIId**.
- XIII. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IVa**.
- XIV. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IVb**.
- XV. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IVc**.
- XVI. Claims 1-21, 23-49, directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **IVd**.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Applicants respectfully traverse the restriction requirement at least because the Office has failed to establish an undue burden, and the Requirement is legally improper.

The Office has failed to establish that a search and examination of Groups I - XVI will constitute a serious burden. Applicants respectfully refer the Office to M.P.E.P. § 803, which sets forth the criteria and guidelines for proper requirements for restriction. The M.P.E.P. instructs as follows

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, Applicants respectfully submit that the Office has not demonstrated that examining Groups I - XVI together will constitute a serious burden.

In addition, Applicants traverse the Restriction Requirement because the Office is attempting to improperly carve up the claimed invention. It is noted that the Office is requiring restriction within independent claims.

Applicants have a statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter regarded as the invention in the manner Applicants choose. Issuing a restriction requirement within a claim with the idea that Applicants would have to carve up that claim and pursue the non-elected subject matter in a separate application violates this right under 35 U.S.C. § 112. Indeed, the predecessor to the Federal Circuit has characterized such action as tantamount to a refusal to examine. *In re Weber*, 198 USPQ 328 (CCPA 1978); *In re Haas*, 198 USPQ 334 (CCPA 1978).

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Accordingly, Applicants also traverse the restriction requirement on the ground that it is legally improper.

To be fully responsive, however, Applicants elect, with traverse, Group II as described by the Office; the group directed to compositions and methods comprising treating a keratin material using an organometallic compound obtained from a precursor of formula **Ib**. At least claims 1-49 read on the elected Group.

Additionally, the Office requires an election of one of the groups of metals in the list bridging pages 12 and 13 of the Requirement. The election of species requirement is respectfully traversed, as the Office has failed to establish that a search and examination of all species would unduly tax the resources of the PTO. Nevertheless, in order to be fully responsive, Applicants elect silicon (Si) as the subspecies of metal.

If the Office chooses to maintain the election of species requirement, Applicants expect that the Office, if the elected species is found allowable, will continue to examine the full scope of claims 1-49 to the extent necessary to determine the patentability of these pending claims, i.e., extending the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 2, 2002

By: 

Brian M. Burn
Reg. No. 44,455

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
-202.408.4000-
Fax 202.408.4400
www.finnegan.com